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MAR 23 2011

OFFICE OF PETITIONS

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Pittsburgh, PA 15213

In re Patent of Kotovsky	:	
Patent No. 6,997,267	:	
Issue Date: February 14, 2006	:	Decision on Petition
Application No. 10/090,515	:	
Filing Date: March 1, 2002	:	
Attorney Docket No. KOTOV-10	:	

This is a decision in response to the petition under 37 C.F.R. § 1.377 filed October 12, 2010.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.377."

Procedural Background

Ansel Schwartz is the attorney of record. Schwartz's standard practice is to submit maintenance fee payments via credit card using the Office's website. However, in situations where the entity status needs to be changed for the patent, the maintenance fee is submitted by first class mail.

The 3.5 year maintenance fee could have been timely paid with the surcharge under 37 C.F.R. § 1.20(h) as late as February 16, 2010.¹

On or about February 16, 2010, Schwartz initially went to the Office's website to pay the maintenance fee for the instant patent. Schwartz then recognized the status for the patent needed to be changed from small entity to large entity.

On February 16, 2010, Schwartz mailed the maintenance fee by Express Mail because he wanted to be able to track the package since the package was being mailed on the last day the fee could

¹ February 14, 2010, was a Sunday and February 15, 2010, was a federal holiday.

be timely paid. Schwartz had never made a payment for a maintenance fee for a U.S. patent using Express Mail prior to February 16, 2010.

The package mailed February 16, 2010, included the following items:

1. "Notification of Loss of Status as a Small Entity" (1 page),
2. Maintenance fee transmittal letter (2 pages),
3. "Certification of Express Mailing (CEM) 37 C.F.R. § 1.10" (1 page), and
4. A check for \$1060.

Schwartz used the following address for the Office when he mailed the February 16, 2010 package:

United States Patent and Trademark Office
P.O. Box 371611
Pittsburg, PA 15250-1611

Schwartz states he used the address above because the Office's website included a webpage² stating,

Unless submitted electronically over the Internet at www.uspto.gov, payments of maintenance fees in patents should be mailed through the United States Postal Service to:

United States Patent and Trademark Office
P.O. Box 371611
Pittsburg, PA 15250-1611

The United States Postal Service ("USPS") returned the Express-Mail Package to Petitioner with the following stamped language added to the envelope: "Return to Sender No Longer at this Box Number."³

A petition under 37 C.F.R. § 1.377 was filed March 12, 2010.

A decision dismissing the petition was mailed August 31, 2010.

Discussion

The petition does not establish the Office physically received the maintenance fee and surcharge mailed February 16, 2010, and then returned the correspondence to the USPS to be returned to Petitioner. Absent proof the Office physically received the fees, the petition must satisfy the

² A copy of the webpage, which appears to have been printed on February 22, 2010, was filed with the prior petition as Exhibit C.

³ Although the petition states a copy of the envelope is included as Attachment D, the Office is unable to locate the attachment. However, a copy of the envelope is unnecessary for the Office to treat the merits of the petition.

requirements set forth in 37 C.F.R. § 1.8(b) and/or 37 C.F.R. § 1.10(e) in order to demonstrate the fees were filed prior to expiration of the patent.

37 C.F.R. § 1.8(b) only applies to correspondence mailed or transmitted in accordance with 37 C.F.R. § 1.8(a), which requires mailed to correspondence to be “[a]ddressed as set out in § 1.1(a),” and 37 C.F.R. § 1.10(e) states the rule only applies to “correspondence addressed as set out in § 1.1(a).” Therefore, the fees cannot be considered timely filed unless the fees were addressed as set out in 37 C.F.R. § 1.1(a).

The fees were not mailed to any of the addresses identified in 37 C.F.R. § 1.1. Therefore, the provisions of 37 C.F.R. § 1.8(b) and 37 C.F.R. § 1.10(e) have not been satisfied and the record fails to establish the fees were filed prior to expiration of the patent. Since the fees were not timely filed prior to expiration of the patent, the petition cannot be granted.

The requirement for the correspondence to be sent to an address identified in 37 C.F.R. § 1.1 *might* include correspondence sent to other *valid* addresses for the Office. However, the petition fails to indicate the Pittsburgh address was a valid address for the Office on February 16, 2010. For example, the petition does not state the same address was successfully used when paying other maintenance fees during late 2009 or 2010.

In view of the prior discussion, the petition cannot be granted.

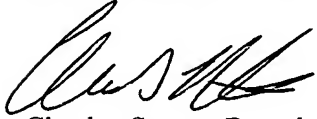
Petitioner may wish to consider filing a petition under 37 C.F.R. § 1.378(b) to reinstate the patent. A petition under 37 C.F.R. § 1.378(b) must be accompanied by a \$700 surcharge and must show the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition was unavoidable. Petitioner should feel free to contact the undersigned with any questions concerning filing a petition under 37 C.F.R. § 1.378(b) or any other matter addressed in the instant decision. A PDF-fillable petition under 37 C.F.R. § 1.378(b) form can be found at: <http://www.uspto.gov/web/forms/sb0065.pdf>.

Unless filed by EFS Web, further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450
By facsimile: (571) 273-8300
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Charles Brantley', with a stylized flourish at the end.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions